

PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(healre01.012)

5 **Applicant:** Falchuk, et al. **Confirmation No.:** 7848

Application No: 09/730,299 **Group Art Unit:** 3626

Filed: 12/05/2000 **Examiner:** Pass, Natalie

10 **Title:** *A medical consultation management system*

Commissioner for Patents
15 Alexandria, VA 22313-1450
 Filed via EFS

Response to Non-compliant Amendment

20 see attached compliant amendment

Applicant: Falchuk, et al. **Confirmation No.:** 7848
Application No: 09/730,299 **Group Art Unit:** 3626
Filed: 12/05/2000 **Examiner:** Pass, Natalie
Title: *A medical consultation management system*

Commissioner for Patents
Alexandria, VA 22313-1450
Filed via EFS

Response to a non-final Office action in an RCE under 37 C.F.R. 1.111

Summary of the prosecution

This response is in reply to a non-final Office action mailed 11/19/2007 in the RCE filed 8/2/2007 in the above patent application. Claims 1-4 were presented in the RCE for examination. In the non-final Office action, Examiner rejected claims 1-4 under 35 U.S.C. 112, first paragraph as containing subject matter which was not described in the Specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. Examiner further rejected claims 1-2 under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A., "Continuing medical education on the World Wide Web. Military telemedicine on-line today, in: *Research, Practice, and Opportunities, Proceedings of the National Forum*, 27-29 March, 1995, hereinafter "Fontelo". Claims 3 and 4, finally, were rejected under 35 U.S.C. 103 as unpatentable over the combination of Fontelo with Galewitz, P., "Doctors can now get continuing education on line", *Palm Beach Post*, July 8, 1996, henceforth "Galewitz". Applicants are traversing the rejections. References to the Specification of 09/730,299 in the following are made using figure and line numbers from U.S. Patent 6,256,613, of which the present patent application is a divisional.

Traversal

The rejection of claims 1-4 under 35 U.S.C. 112, first paragraph

Claims 1-4 as amended are supported in the Specification by FIG. 1 and the description
 5 of FIG. 1 which runs from col. 3, line 26 of 6,256,613 through col. 5, line 67.

The rejection of claim 1

In the following, references to FIG. 1 and to the description have been added to claim 1:

- 10 **1.** A method of providing continuing medical education credit to a first
 physician (20, col. 3, lines 27-28) for a consultation between the
 first physician and a second physician (30, col. 4, lines 25-26),
 the method comprising the steps performed in an intermediary (10, col.
 3, line 28-col. 5, line 67) and which is coupled by a
 15 telecommunications system to both the first and second physicians
 of:
 - arranging and conducting the consultation via the
 telecommunications system under supervision of a medical
 information specialist (embodied in the "staff physician") in the
 20 intermediary who is neither the first nor the second physician (32,
 36, 37, 38, 50; col. 3, line 27-col. 4, line 61)
 - receiving a comment (55, col. 4, line 63-col. 5, line 34)
 made with regard to the consultation via the telecommunications
 system from the second physician in the intermediary; and
 - 25 providing the comment to the medical information
 specialist (48, 56, col. 5, lines 13-17), the intermediary being
 empowered to certify that the first physician is entitled to
 continuing medical education credit (70, col. 5, lines 48-67) and
 the medical information specialist evaluating the consultation
 30 represented by the comment (80, col. 5, lines 48-58, 61-63) to
 determine whether the first physician is entitled to continuing
 medical education credit on the basis of the consultation
 represented by the comment and if the first physician is entitled,
 certifying that the first physician is entitled to the continuing
 35 medical education credit in a database accessible from the
 intermediary and otherwise not so certifying (82, col. 5, lines 63-
 67).

The only element of the above mapping of FIG. 1. and its description to claim 1 that is
 40 not straightforward is that the description of FIG. 1 shifts from the active to the passive
 voice at col. 5, line 11. From col. 3, line 26 through col. 5, line 11, the use of the active

voice makes it clear the activities set forth at 36, 37, 38, 39, and 50 are performed by the staff physician. The use of the passive voice following col. 5, line 11 renders the role of the staff physician less clear, but given the staff physician's role in the activities of 36, 37, 38, and 50 and the fact that it is clearly the staff physician who provides tutorial materials to the first physician (col. 4, lines 14-19), no one skilled in the relevant arts would doubt that the staff physician plays a role in activities 55, 63, and the activities of accreditation module 70 similar to his or her role in the activities of 36, 37, 38, and 50. FIG. 1 and the description at col. 3, line 26 through col. 5, line 67 thus "reasonably convey to one skilled in the relevant art that the inventors at the time the application was filed has possession of the invention of claim 1".

The rejection of claim 2

The added limitation of claim 2 is shown at 39 in FIG. 1 and described at col. 3, line 49-col. 4, line 19.

The rejection of claims 3 and 4

The added limitations of claim 3 and 4 are shown at 70 in FIG. 1 and described at col. 5, lines 48-67.

The rejections under 35 U.S.C. 103

Claims 1 and 2 are rejected under 35 U.S.C. 103 as obvious over Fontela and claims 3 and 4 are rejected under 35 U.S.C. 103 as obvious over the combination of Fontela

The claims presently in the application are all directed to a method of "providing continual medical education credit to a first physician for a consultation between the first physician and a second physician" where the method includes the step of "arranging and conducting the consultation via the telecommunications system under supervision of a *medical information specialist* in the intermediary who is neither the first nor the second physician" (emphasis added). Further steps in the method concern a "comment made with regard to the consultation" which is "provided to the medical information specialist". The medical information specialist then "evaluat[es] the consultation

represented by the comment to determine whether the first physician is entitled to continuing medical education credit on the basis of the consultation represented by the comment”.

- 5 In her rejection, Examiner cites Fontelo, page 141, col. 2, paragraphs 2-3, the paragraph bridging page 141, col. 2 and page 142, col. 1, and page 142, col. 2, par. 1. The cited locations describe how the World Wide Web may be used for CME and how participating physicians may receive credit for the CME. As disclosed in the reference, a user of Fontelo’s system simply employs a Web browser to examine CME materials at a
- 10 Web site. To receive credit for the CME, the user returns a question and evaluation form to the Web site. Examiner combines Fontelo with Official Notice to find the claim limitation of “otherwise not so certifying”

- Neither the cited locations nor any thing else in Fontelo describes what is being claimed
- 15 in Applicants claim 1, namely granting CME in the context of a *medical consultation* which is arranged and conducted by an intermediary between a first and second physician and supervised by a *medical information specialist* in the intermediary who is neither the first nor the second physician and who further evaluates the consultation to determine whether the first physician is entitled to continuing medical education credit on the basis
- 20 of the consultation represented by the comment. Since Fontelo does not disclose these limitations, the reference combined with Official Notice does not disclose all of the limitations of claim 1 and Examiner has not made the *prima facie* case of obviousness required by MPEP 2142.

25 *Dependent claims 2-4*

- The rejections of these claims all depend upon the rejection of claim 1 based on Fontelo; since that rejection is without basis, so are the rejections of these claims without basis. In particular, the additional steps of claims 2-4 are “performed in the intermediary under supervision of the medical information specialist”. Since there is no disclosure in Fontelo
- 30 of an intermediary or of a medical information specialist who supervises the consultation in the intermediary, there is also no disclosure of the additional steps of these claims and

these claims are additionally patentable in their own rights over the Fontelo and Galewitz references.

Conclusion

5 Applicants have demonstrated that the claims of the RCE are fully supported by the Specification as filed and that the references cited by Examiner do not establish the *prima facie* case of obviousness required for a rejection under 35 U.S.C. 103. The claims are consequently patentable over the references. Applicants therefore request that Examiner allow the claims. A fee for a 1-month extension of time accompanies this response. No
10 other fees are believed to be required; should any be, please charge them to deposit account number 501315.

Respectfully submitted,

/Gordon E. Nelson/

Attorney of record,

Gordon E. Nelson

57 Central St., P.O. Box 782

Rowley, MA, 01969,

Registration number 30,093

Telephone: 978-948-7632

Fax: 866-723-0359

4/16/2008

Date